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09/220,910	12/24/1998	THOMAS E. WALSH	2207-6033	5446

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EXAMINER

VU, THONG H

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

H-G

Office Action Summary

Application No.

09/220,910

Applicant(s)

WALSH, THOMAS E.

Examiner

Thong H Vu

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15, 17-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15, 17-21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2152

1 This office action is in response to Amendment A filed 11/26/01. Claims 1,16 and 22 are canceled. Amended claims 2,8,9,11,13,15,17,18,20,21 and 23-27 are pending. The rejection is cited as stated below.

2 Claims 2-9,12-15,17-21,23-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Krause [5,526,520].

3 As per claims 2,17,23,27,30 Krause discloses a method for identifying a secondary document relative to a primary document comprising: determining if said primary document includes an indicator; and identifying said secondary document if said primary document includes said indicator [col 4 lines 15-65, col 9 line 28-col 10 line 5]; attaching said secondary document to said primary document if said primary document includes said indicator [col 2 lines 45-52, col 10 lines 6-27]

4 As per claim 3, Krause discloses said secondary document has a filename and a location, the method further comprising determining at least one of said filename and said location of said secondary document [col 6 lines 35-45].

5 As per claim 4, Krause discloses said secondary document has a filename and a location, the method further comprising determining at least one of said filename and said location of said secondary document as a function of a user input [col 6 lines 35-45].

6 As per claims 5,18,24 Krause discloses said primary document includes at least one word, and wherein determining at least one of said file name and said location of said secondary document is performed as a function of said at least one word as a design choice of frame name [col 6 line 35-col 7 line 28].

Art Unit: 2152

7 As per claim 6, Krause discloses said primary document includes a plurality of words, and wherein determining at least one of said filename and said location of said secondary document is performed as a function of said plurality of words within a predetermined proximity of said indicator included in said plurality of words as a design choice of frame name [col 6 line 35-col 7 line 28].

8 As per claims 7, 19 Krause discloses associating a predetermined word with at least one of said filename and said location of said secondary document, wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word as a design choice of frame name [col 6 line 35-col 7 line 28].

9 As per claims 8,20,25,28 Krause discloses said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases as a design choice of frame name [col 6 line 35-col 7 line 28].

10 As per claims 9,21,26 Krause discloses determining if said at least one word includes one of said indicator is performed using syntactic processing or menu [col 6 line 35-col 7 line 28].

11 As per claim 12, Krause discloses sending said primary document and said secondary document attached thereto to a printing device [Krause col 2 line 48]

12 As per claim 13, Krause discloses said primary document and said secondary document attached thereto to a recipient via facsimile or scanner [Krause col 2 line 48]

13 As per claim 14, Krause discloses said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of a user input [Krause col 6 lines 35-45].

Art Unit: 2152

14 As per claim 15, Krause discloses adding at least one additional indicator to said indicator as a function of a user input [Krause col 6 lines 35-45].

Thus the claims 2-9,12-15,17-21,23-30 is anticipated by the prior art.

15 Claims 10-11,29 are rejected under 35 U.S.C. § 103 as being unpatentable over Krause [5,526,520] in view of Narasimhan et al [Narasimhan 6,073,165]

16 As per claim 10, Krause is silent to discloses said primary document includes an email message. However Narasimhan discloses a message processing system including the first message which is further processed to create a second message such as an email message with file attachment [Narasimhan col 1 lines 40-60, col 5 lines 3-17].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Krause and Narasimhan's teaching in order to utilize the email with attachment message feature. By doing so it would provide the fast and easy way to send the document to client through a large network such as Internet.

17 As per claim 11, Krause-Narasimhan disclose sending said e-mail message and said secondary document attached thereto to a recipient via a communications device [Narasimhan col 1 lines 40-60, col 5 lines 3-17].

18 As per claim 29, Krause-Narasimhan disclose said primary document includes a list of at least one address corresponding to at least one recipient to receive said primary document, further comprising attaching said address of said recipient to said list of said at least one address as inherent feature of email message wherein an email is primary document includes an indicator as an address of recipient .

Art Unit: 2152

Thus, as explained above, the system and method of claims 12-15,17-21,23-30 is obvious in view of the prior art.

Response to Arguments

19 Applicant's arguments filed 11/26/01 have been fully considered but they are not persuasive to overcome the prior art.

20 As per claims 2,17,23,27 and 30 applicant argues the prior art does not teach the determining if said primary document includes an indicator identifying said secondary document if said primary document includes said indicator; and attaching said secondary document to said primary document includes said indicator. Examiner notes the prior art taught the primary document includes a reference indicator which references the secondary document and can automatically call-up a page or frame file [Krause col 2 lines 45-52, col 4 lines 30-35]

21 Applicant argues the prior art does not teach “determining” if an indicator is included in the primary document and then “identifying” the secondary document as result of the present of the indicator. Examiner notes the prior art disclose the “determining” is equivalent to electronically identifying a selected document [Krause col 3 lines 44-53] and “identifying” the secondary document as result of the indicator as specially identified by a name file [Krause col 3 line 63], identify a reference indicator which references the secondary document [col 4 lines 25-65].

Thus, the applicant argument is not persuasive at this point and the rejection is sustained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2152

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H Vu whose telephone number is 703-305-4643. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6606 for regular communications and 703-308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

Application/Control Number: 09/220,910

Art Unit: 2152

Thong Vu
Patent Examiner
Art Unit 2152

Page 7



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